

REMARKS

In the Official Action, the Examiner withdrew all the previous rejections except the rejection under 35 U.S.C. §102(b) as allegedly being anticipated by JP 9-241637 which has been referred to as "Okubo" or the " '637". In maintaining the rejection, the Examiner has recognized that the term "consisting essentially of" limits the claims to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention, but has then cited *PPG Industries Inc. v Guardian Industries Corp.*, 156 F.3d 1351, 48 USPQ2d 1351 (Fed. Cir. 1998) for the proposition that where there is no clear indication in the specification or claims of what the basic and novel characteristics are, "consisting essentially of" will be construed as the equivalent of "comprising". Based on this construction, the Examiner has maintained that the presence of epigallocatechin, which is expressly identified as an oxygen scavenger, is not excluded by the claims. In addition, the Examiner has noted that while Okubo does not expressly mention a method of treating skin (as recited in the claims), it would be inherent in the use of the product.

Although applicants agree with the Examiner that the term "consisting essentially of" excludes those materials or steps that have a material effect on the basic and novel characteristics of the claimed invention, applicants do not agree that the term permits the interpretation of being the equivalent of "comprising", particularly as it applies to the claims of record. First, applicants take issue with the Examiner's characterization that the *PPG Industries* decision permits the interpretation of the term as being the equivalent of "comprising". Indeed, the court

expressly rejected the patent owner's (PPG's) argument that the term "consisting essentially of" could be interpreted in this way by stating:

That proposed definition [by PPG] is suspect, however, because it would mean that any residual sulfur compound in the glass composition could avoid the "consisting essentially of" limitation only by taking the glass outside the other limitations of the patent. If that definition of "significant effect" were adopted, it would have the effect of converting the critical claim language from "consisting essentially of" to "comprising." ... We therefore reject PPG's argument that the specification requires that the claims of the '886 patent be construed to encompass glass products that contain iron sulfide in any amount, as long as the accused products satisfy the other limitations of the claims.¹

As a result of the court's determination that the "consisting essentially of " language excluded the presence of a certain sulfur compound, the court affirmed the judgment of non-infringement.

Thus, the *PPG Industries* decision does not stand for the proposition which the Examiner has stated. Furthermore, even if it did, it still would not justify a rejection of the claims of record since the claims indicate what the basic and novel characteristics of the invention are. In particular, independent claim 19 recites a "method of treating skin comprising applying a cosmetic composition consisting essentially of citrulline in an amount of 0.5 mM to 60 mM to skin so that active oxygen in the skin is scavenged by the citrulline." It is apparent from the plain language of this claim that basic and novel characteristics of this aspect of the invention is the treatment of the skin by the defined composition "so that the active oxygen in the skin is scavenged by the citrulline." Accordingly, any additional component which materially affects the ability of the composition to scavenge active oxygen is excluded. A similar analysis exists with respect to independent claims 25

¹ 156 F.3d 1355, 48 USPQ2d 1356.

and 26 which recite "to decrease active oxygen content". That is, any additional component which materially affects the ability of the composition to decrease active oxygen content is excluded.

With a proper understanding of the what the claims of record define, applicants firmly maintain that Okubo cannot be used to reject the claims. Okubo relates to a composition capable of removing active oxygen free radicals using a composition that comprises an active oxygen free radical scavenger and one or more substances selected from uronic acids, uronides, mucopolysaccharides and amino acid-peptides. The free radical scavenger is a catechin or a tannin-polyphenol and is exemplified by epigallocatechin (EGC) in each and every illustrative Example set forth in Table 1. While citrulline is included amongst the amino acids set forth in paragraph [0071], it is not disclosed as being the active oxygen free radical scavenger, but rather as an auxiliary agent. Furthermore, Okubo teaches that citrulline by itself does not have a strong scavenger effect.

The express teaching in Okubo that a free radical scavenger, such as a catechin or tannin-polyphenol and particularly epigallocatechin, must be present would clearly have a material effect on the ability of the composition to scavenge active oxygen or decrease the active oxygen content. Thus, since the stated free radical scavenger is an essential component in the composition of Okubo and is excluded by the claims, the anticipation rejection set forth in the Official Action cannot stand. Moreover, the Examiner's stance on anticipation based on "inherency" also must fall since it would not be inherent to treat skin or otherwise use a composition without the free radical scavenger that Okubo teaches must be present.

Accordingly, the claims of record are clearly patentable in all respects and applicants therefore request reconsideration and allowance of the present application.

Should the Examiner wish to discuss any aspect of the present application, she is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

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